

REMARKS

The present invention relates to a propylene polymer and its moldings, and also to a method for producing propylene polymers. Precisely, the invention relates to a propylene polymer of which the advantages are that its modulus of elasticity is well balanced with its melting point, that its low-temperature moldability and workability are good and that it has well-balanced mechanical strength; and relates to moldings obtained by molding the polymer; and also relates to a method for producing such propylene polymers. As having good low-temperature heat-sealability, good transparency, good scratch resistance and good mechanical strength, the propylene polymer of the invention is suitable for wrapping or packaging films.

The present invention is drawn to a propylene polymer having a combination of properties not disclosed or suggested by the prior art. As recited in above-amended Claim 1, the invention is a propylene polymer which satisfies the following requirements (1) to (4): (1)  $\Delta H \geq 0.45 T_m + 22$ , wherein  $\Delta H$  is a heat of fusion (J/g) and  $T_m$  is a melting point ( $^{\circ}\text{C}$ ) measured through differential scanning calorimetry; (2)  $110 \leq T_m \leq 140$ , wherein  $T_m$  is the melting point; (3)  $T_h \leq 5$ , wherein  $T_h$  is a half-value width ( $^{\circ}\text{C}$ ) of the peak top of its elution curve, the elution curve being obtained in programmed temperature fractionation where a sample solution in o-dichlorobenzene is fractionated by raising the temperature from  $0^{\circ}\text{C}$  to  $135^{\circ}\text{C}$  at a heating rate of  $40^{\circ}\text{C/hr}$ ; and (4) an intrinsic viscosity  $[\eta]$  of 0.5 to 5 dl/g when measured in a solvent of tetralin at  $135^{\circ}\text{C}$ .

The rejection of Claim 15 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the description requirement therein, is respectfully traversed. Claim 15, prior to amendment, recited that  $R^1$  to  $R^{11}$  were each independently hydrogen or another group as recited in the Markush group thereof. The subject amendment limited  $R^8$  and  $R^{11}$  to hydrogen, but retained the same definition for  $R^1$  to  $R^7$  and  $R^9$  to  $R^{10}$ . An amendment that simply deletes members

of a Markush group does not raise a description requirement issue. See *In re Driscoll*, 562 F.2d 1245, 1249-50, 195 USPQ 434, 438 (CCPA 1977) (copy enclosed).

In holding that a disclosure of a group of chemical compounds containing a plurality of groups defined by Markush terminology, one of which groups contained 14 members, *described* the same group of compounds otherwise identical except that the 14-member group was now limited to only one of the members, the court in *Driscoll* stated:

Were the board's decision permitted to stand, future applicants, particularly in cases of this nature, would in all likelihood find themselves in the predicament reflected in the following observation by Judge Learned Hand:

If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new "invention," only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and proceeding by the successive incorporation of more and more detail, until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. *It is impossible to imagine any public purpose which it would serve.*

*Id.* at 1250 (quoting *Engineering Development Laboratories v. Radio Corp. of America*, 153 F.2d 523, 526-27, 68 USPQ 238, 241-42 (2d Cir. 1946)).

Notwithstanding *Driscoll*, Applicants do have supporting basis for excluding bridged indenyl complexes which bear substituents in the 4- and 7- position. Indeed, in Examples 2-5, the 4- and 7- positions are unsubstituted, i.e., contain hydrogen.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1, 2, 12-14, 15, 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over JP 11-130807 (Kanamaru et al) is respectfully traversed. The Examiner's rationale is that since the method of preparation of the polymers in Kanamaru et al is the same as that claimed, then the polymer would, in effect, exhibit the same properties as the

presently-claimed polymer, including intrinsic viscosity, which the Examiner admits is not disclosed in Kanamaru et al.

In reply, the submitted Kanamaru Declaration, of record, describes repetition of each of Examples 2-4 of Kanamaru et al., described as Comparative Experiments 1-3, respectively, in the Kanamaru Declaration.<sup>1</sup> The data show that the intrinsic viscosity of each of the Comparative Experiments was less than the presently-recited minimum of 0.5 dl/g. Note further that the Examiner's rationale no longer holds, because the polymerization catalyst of formula (1) in Claim 15 differs from the catalyst in Kanamaru et al. The mono-bridged metallocene of Kanamaru et al. must have substituent groups on both the 4- and 7-positions ( $R^5$  and  $R^6$ ) of the 2-indenyl ligand, whereas the recited metallocene of Claim 15 has no substituent group at the 4- and 7-positions ( $R^8$  and  $R^{11}$ ) of the 2-indenyl ligand, as discussed above with regard to the rejection of Claim 15 under 35 U.S.C. § 112.

In response to the above arguments, because the Examiner considers Claim 15, in effect, as claiming new matter, the Examiner reads the claim as if the "new matter" limitation is not there. This is improper, and is in violation of Office policy. Indeed, as MPEP 706.03(o), Examiner Note 3, mandates, "[a]s to any other appropriate prior art . . . rejection, the new matter **must** be considered as part of the claimed subject matter and can not be ignored" (emphasis added.) See also MPEP 2143.03. Thus, the Examiner must treat the claims as he or she finds them. Whether or not the term is new matter is a separate issue, and has been discussed above with regard to the rejection under 35 U.S.C. §112, first paragraph.

For all the above reasons, it is respectfully requested that the rejection over Kanamaru et al. be withdrawn.

The rejection of Claims 1, 2, 12-14 and 16-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. 6,339,135 (Kashiwamura et al.), is respectfully traversed.

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<sup>1</sup> Of record is an English translation of Examples 2-4 of Kanamaru et al.

Kashiwamura et al is drawn to double crosslinking type biscyclopentadienyl transition metal compounds. However, the present claims are now limited to single crosslinking compounds, as clearly set forth in Claim 15. Since Claims 17 and 18 depend on Claim 15, they necessarily have all the limitations thereof. Applicants note the Examiner's reliance on Claim 16; however, Claim 16 has been cancelled. Note also the discussion above with regard to the rejection over Kanamaru et al that it is impermissible to ignore claim limitations for purposes of rejections over prior art, even if such limitations are believed to be new matter.

For all the above reasons, it is respectfully requested that the rejection over Kashiwamura et al be withdrawn.

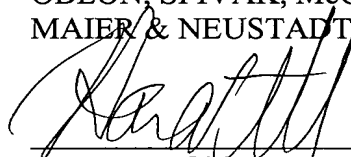
Applicants note the Examiner's finding that the Information Disclosure Statement (IDS) filed February 24, 2003 "was not received." However, according to the PTO's Patent Application Information Retrieval (PAIR) system, the IDS was received. **Submitted herewith**, with a copy of the filing receipt, is a copy of the IDS, and a printout from the PAIR system evidencing filing of the IDS on February 24, 2003. The Examiner is respectfully requested to initial the Form PTO 1449 submitted therewith or herewith, and include a copy thereof with the next Office communication.

Application No. 09/784,444  
Reply to Office Action of November 5, 2003

All of the presently pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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OSM M&N File No. 203370US0X PCT  
Serial No. 09/784,444

Dept.: PP

By: NFO/hc

In the matter of the Application of: Masami KANAMARU, et al.

For: PROPYLENE POLYMER, MOLDING OBJECT THEREOF, AND PROCESS  
FOR PRODUCING PROPYLENE POLYMER

Due Date: 02-25-03

The following has been received in the U.S. Patent Office on the date stamped hereon:

- Dep. Acct. Order Form
- Information Disclosure Statement
- Cited References (3)
- EUROPEAN Search Report
- PTO-1449



Docket No. 203370US0X PCT/hc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Masami KANAMARU, et al.

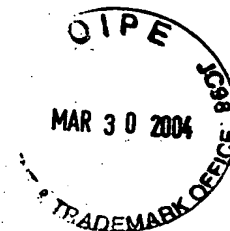
SERIAL NO: 09/784,444

GAU: 1713

FILED: February 26, 2001

EXAMINER:

FOR: PROPYLENE POLYMER, MOLDING OBJECT THEREOF, AND PROCESS FOR PRODUCING PROPYLENE POLYMER



INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- ☒ The applicant(s) wish to make of record the references cited in the attached European Search Report listed on the attached form PTO-1449. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.
- ☐ A check is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- ☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.
- ☐ A check is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- ☐ Each item of information contained in this information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

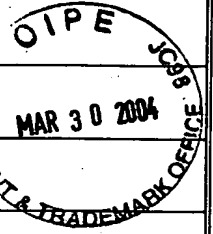
Respectfully submitted,

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Form PTO 1449  
(Modified)U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICEATTY DOCKET NO.  
203370US0X PCTSERIAL NO.  
09/784,444

## LIST OF REFERENCES CITED BY APPLICANT

APPLICANT  
Masami KANAMARU, et al.FILING DATE  
February 26, 2001GROUP  
1713

## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AO	0 970 974	01/12/2000	EUROPE		
	AP	1 006 149	06/07/2000	EUROPE		
	AQ	1 095 951	05/02/2001	EUROPE		
	AR					
	AS					
	AT					
	AU					
	AV					

## OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	AW	
	AX	
	AY	
	AZ	<input type="checkbox"/> Additional References sheet(s) attached

Examiner

Date Considered

\*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.